

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant :	Kurt C. McCracken	Art Unit :	3625
Serial No. :	09/610,828	Examiner :	Nicholas Rosen
Filed :	July 6, 2000	Conf. No. :	5424
Title :	MANAGING INVESTMENT ASSETS		

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Overall, the examiner's argument is that the appellant is claiming merely a combination of "standard business practices." (Answer, p. 13, last 3 lines.)

To the contrary, the automated system claimed goes beyond standard business practices. The claims describe a novel investment process and the automated system required to implement it.

The examiner has not presented any evidence that the business practices that he alleges could have been combined to implement this investment process were combined by anyone prior to the appellant's invention, and there is no suggestion in any of the many references produced by the examiner to make such a combination. It is only by following the roadmap of the appellant's disclosure that the examiner has been able to string together details from eleven different references to approach what is claimed.

In defense of his hindsight reasoning, the examiner argues that "it is not plausible to believe" that the appellant was the first to use a machine to "(a) track each investor's basis in an investment entity, (b) allocate each investor's basis in his interest in the investment entity among properties acquired by the investment entity, and (c) track the allocated basis of each investor as a result of a succession of transactions." (Answer, page 18.) The examiner is merely begging the very question that is before the Board. Whether the examiner finds it implausible that the appellant was the first to assemble the claimed elements is irrelevant to the Board's consideration of the question. Eleven papers and articles, each allegedly disclosing one or a few features of the detailed claims, strung together based on nothing more than allegedly "obvious advantages," do not show that the claimed invention was already well-known or obvious at the time of the appellant's invention.

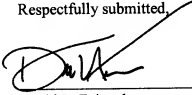
The examiner again denigrates the appellant's argument, stating that the combination was obvious "for the obvious advantage of not having to employ large numbers of scribes to make the necessary calculations on paper with quill pens." Appealing though this image may be, it misses the point. The appellant is not claiming the automation of an existing process. What is claimed is a *novel* process, which is only valuable if automated, and the computer-implemented *process* necessary to automate it. The examiner also argues, with regard to claim 16, that "making more money is a famous and notoriously strong motive," but this is merely a motivation to improve, not a motivation to make any specific improvement. The examiner fails to explain how this motivation would lead specifically from the diverse array of cited references to the combination of features claimed. (Answer, pages 20-21.)

For these reasons, and the reasons stated in the Appeal Brief, the appellant submits that the final rejection should be reversed.

Please apply any charges or credits to deposit account 06-1050, attorney docket 12016-002001.

Respectfully submitted,

Date: 2/23/07



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